

*REMARKS*

In response to the Official Action mailed May 28, 2004, Applicants amend their application and request reconsideration. In this Amendment, no claims are added or canceled so that claims 1-19 remain pending. No new matter has been added.

Claims 6, 17, and 18 are stated to be allowable.

Claim 1 is amended to correct an antecedent basis issue.

The Official Action rejects claims 1, 12, and 17 under 35 U.S.C. § 112 as indefinite for containing terms lacking antecedent basis. That rejection is moot in view of the amendment of claim 1. This minor amendment overcoming a rejection as to form, by changing “the” to “a”, cannot raise any new issue of substance and, therefore, should be entered.

The Official Action rejects claims 1-5, 7-16, and 19 as unpatentable over Kumar et al. (US Patent 6,416,471, hereinafter Kumar) in view of “logical reasoning.” That rejection is traversed.

Applicants initially note that Kumar is not analogous art, and therefore cannot support the rejection. “In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See MPEP 2141.01(a). Kumar relates to monitoring the vital signs of a patient, i.e., a living thing (see Abstract of Kumar). By contrast, the present invention relates to a monitoring system for monitoring the physical and electrical characteristics of an electrical device, such as an electric motor in a factory. Thus, Kumar is clearly not in the field of Applicants' endeavor.

Kumar is also not reasonably pertinent to the particular problem with which Applicants were concerned. “A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem.” *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992). A reference relating to measuring a patient's vital signs would not have logically commended itself to the attention of an inventor concerned with the monitoring of operational characteristics of an electric device. It is unreasonable to expect that one skilled in the art of plant monitoring would turn to the health care arts when considering the problem of monitoring the operational characteristics of an electrical device. Accordingly, Kumar is not reasonably pertinent to the problem solved in the present invention.

Kumar is non-analogous art since it fails both tests of *Oetiker*. As a result, Kumar cannot be used, as in the Official Action, in a rejection for obviousness. MPEP 2141.01(a). For that reason, the rejection based on Kumar is erroneous and must be withdrawn. Upon that withdrawal, the entire rejection fails and all of the claims 1-19 must be allowed.

Even if Kumar were analogous prior art that could be applied in rejecting claims, the rejection still could not be properly maintained because Kumar fails to teach or suggest all of the limitations of amended claim 1. The Official Action acknowledges that Kumar fails to teach the electric device of amended claim 1. The Official Action contends that it would have been obvious to one of ordinary skill in the art to modify Kumar to monitor an electric device instead of a patient. However, to support such a contention “it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification.” See *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). The Official Action fails to provide sound reasoning as to how one of ordinary skill in the art would, upon review of Kumar, have the technical ability to modify Kumar to include an entirely different sensor, detect entirely different data, and analyze that data in an entirely different manner using entirely different analysis means. One of ordinary skill in the art to which Kumar pertains would, in fact, not have the technical ability to make such modifications based merely on Kumar, ordinary skill, and logical reasoning.

Moreover, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there can be no suggestion or motivation to make the proposed modification. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). The modification of Kumar, as proposed by the Official Action, to monitor an electrical device instead of a patient, would surely render Kumar unsatisfactory for its intended purpose. Because there is no motivation to modify Kumar, the rejection is erroneous and should be withdrawn.

Furthermore, Kumar fails to teach or suggest a controller having a memory for storing the detection data obtained by the detection of said detector, for storing with the detection data a device state *based on a preset detection start program*, and outputting the detection data stored in the memory to the first communication signal converter *based on a preset communication start program* that runs in correspondence with storage of the detection data. Kumar fails to disclose anything suggesting storing or outputting data based on a preset communication start program.

Finally, “logical reasoning” is not prior art, it is a chimera. The metes and bounds of logical reasoning cannot be specified. This phantom source of prior art is limitless. It is not

the objective teaching required by *In re Fine*, 837 F.2d 1071, 5 USPQ 2d 1596 (Fed. Cir. 1988), and MPEP 2143.01 to support a legally correct rejection. On this basis alone, the rejection cannot be properly maintained.

Thus, Kumar is not analogous art, there is no motivation to modify Kumar as proposed by the Official Action, and the combination of Kumar and the Official Action's "logical reasoning" fail to teach or suggest all of the limitations of amended claim 1. Accordingly, for any and all of these reasons, the rejection is erroneous and should be withdrawn.

Regarding claim 5, the Official Action asserts that Kumar teaches a power line for supplying an electric device with electric power from a power source device and transmitting the detection data to a communication signal converter via a power line. The power source in Kumar, as pointed to by the Official Action, is a battery, Kumar in no way discloses sending detection data via a connection between an electric device and a battery pack. Thus, the combination of Kumar and "logical reasoning" clearly fails to teach or suggest sending detection data over a power line.

Regarding claim 8, the Official Action fails to provide sound reasoning as to how one of ordinary skill in the art would, upon review of Kumar, have the technical ability to modify Kumar to include an entirely different sensor, detect entirely different data, and analyze that data in an entirely different manner using entirely different analysis means, and further modify Kumar to adapt it for use in an automobile. One of ordinary skill in the art relevant to Kumar would in fact not have the technical ability to make such modifications based merely on Kumar, ordinary skill, and logical reasoning.

The Official Action rejects claim 7 as unpatentable over Kumar in view of "logical reasoning" and further in view of Murata et al. (US Patent 5,487,516, hereinafter Murata). That rejection is traversed.

The rejection of claim 7 relies on the contention that Kumar teaches all of the limitations of amended claim 1. As previously discussed, that contention is erroneous and Kumar is non-analogous art. Murata fails to teach or suggest any of those limitations of amended claim 1 that are absent from Kumar. Accordingly, *prima facie* obviousness has not been established as to claim 7, which depends from amended claim 1. Therefore, the rejection should be withdrawn.

Furthermore, the Official Action fails to provide sound reasoning as to how one of ordinary skill in the art to which Kumar pertains would, upon review of Kumar, have the technical ability to modify Kumar to include an entirely different sensor, detect entirely different data, and analyze that data in an entirely different manner using entirely different analysis

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means, and further modify Kumar to adapt it for use in a train. Applicants respectfully submit that one of ordinary skill in the art would in fact not have the technical ability to make such modifications based merely on Kumar, ordinary skill, and logical reasoning.

Reconsideration and withdrawal of the rejections, as well as prompt allowance of the pending claims, are earnestly solicited.

Respectfully submitted,



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